

REMARKS/ARGUMENTS

Claims 9-12 are under examination in the application. The Office Action mailed on September 12, 2008, includes the following objections and rejections:

1. The Action requires a Statement of Joint Inventorship.
2. Claims 9-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of U.S. Publication No. 2003/0138490 A1 in view of *Clinical Chemistry*, Vol. 46, pp. 1478-1486 (2000).
3. Claims 9-12 are rejected under the nonstatutory, judicially created doctrine of double patenting.

Statement of Joint Inventorship.

Applicants were advised in the Office Action of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a). Applicants hereby re-state that the assignment rights for each inventor were commonly owned by the assignee at the time of each invention as claimed pursuant to 37 C.F.R. § 1.56.

Claim Rejections – Claims 9-12 are rejected under 35 U.S.C. § 103(a).

The Action rejects claims 9-12 as being unpatentable over Hoffman, *Clinical Chemistry*, Vol. 46, pp. 1478-1486 (2000) (“Hoffman”) in view of U.S. Publication No. 2003/0138490 A1, filed by Hu (“Hu”). Applicants respectfully submit that the art cited fails to meet the standard of 35 U.S.C. § 103(a).

In *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known

devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

The Action argues that the art cited is sufficient to support a *prima facie* case of obviousness, however, in its description of the present invention the Action fails to mention a limitation of the claims, namely, that the composition includes a nitrogen-containing functional group. A close review of Hu, specifically, Schemes 1, 2 and 3 (Figures 8C to 8E, respectively), fails to demonstrate that the art cited includes a functional nitrogen group, as such, Hu fails as prior art because it is missing a limitation of the claimed invention. Turning to Hoffman, it neither provides the claimed limitations, nor does it provide sufficient teaching for one of skill in the art to make and use the invention. Hoffman is a general review article that does not include a description of how the functionalized particles with a nitrogen-containing functional group and a tag could be made. As such, the skilled artisan in possession of Hu and Hoffman would be lacking not only one or more limitations of the claims, but do not have sufficient teaching of how to make the present invention. Therefore, Hu and Hoffman fail to provide a *prima facie* case for obviousness.

As such, Hu and Hoffman neither teach all the claim limitations, nor do they provide a reasonable expectation of success. Accordingly, claims 9-12 are not rendered obvious by the combination of Hu and Hoffman. Applicants respectfully request the Examiner withdraw the rejection of claims 9-12 under 35 U.S.C. § 103(a).

Claim Rejections – Claims 9-12 are rejected under the nonstatutory, judicially created doctrine of double patenting over co-pending, co-owned U.S. Patent Application Serial No. 11/660,282.

The Action states the subject matter claimed in the instant application is obvious in light of co-pending patent application Serial No. 11/660,282. A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to overcome the rejection based on a nonstatutory double patenting ground provided the conflicting patent application is shown to be commonly owned with this application. See 37 CFR 1.130(b).

CONCLUSION

In light of the foregoing, Applicants submit that claims 9-12 are in condition for allowance, and an early Notice of Allowance of all pending claims is respectfully solicited. The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: February 11, 2009.

Respectfully submitted,



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